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DECISION ON PETITIONS
UNDER 37 C.F.R. § 1.181

In re Application of:
Ball, William T.
Serial No. 10/732726
Filed: December 10, 2003
Docket: 2017
Title: METHOD AND APPARATUS FOR
ASSEMBLING AND SEALING
BATHTUB OVERFLOW AND WASTE
WATER PORTS

This is a decision on the two petitions filed on December 29, 2005 under 37 C.F.R. § 1.181. One petition requests that the Director of the Technology Center overturn the Examiner's decision to disapprove and not enter a drawing correction as containing new matter and requests the drawing amendment to be entered. The second petition requests the Technology Center Director to withdraw the Examiner's drawing objection that the drawings do not show every feature of the claims.

The petitions are granted-in-part and dismissed-in-part.

In the non-final Office acting mailed May 23, 2005, the Examiner objected to the drawings under 37 CFR §1.83(a) for not showing every feature claimed. In particular, the Examiner objected to the drawings for not showing the "placing", "charging" and "purging" steps set forth in claim 1, and "means for placing", "means for charging", "means for purging" and "means for opening" set forth in claim 9. Applicant responded by submitting two new figure, Figs 7 and 8, with his response filed on August 26, 2005. The Examiner's final rejection mailed October 24, 2005 states that Fig 8 is disapproved for containing new matter with respect to "sealing" and "opening". The Examiner asserts that the description of the "sealing" and "opening" steps associated with the drain port 28 is not found in the originally filed disclosure. The Examiner further asserts in the final rejection that the "proposed Fig. 8 would not obviate the outstanding Rule 83(a) drawing objection even if the drawing correction was otherwise acceptable. Merely placing the recited "-ing" words in boxes does not define what is involved when performing the claimed acts."

A review of the record indicates that applicant amended claim 1 in the response filed August 26, 2005 to change "placing a thin diaphragm over the overflow port and the waste water port" to "sealing a thin diaphragm over the overflow port and the waste water port". Box 110 of new Fig 8 reflects the change to claim 1. It is noteworthy that applicant is referring to two different sealing elements in the original description, membrane 26A is associated with the waste water port (see page 7, line 16 of the original specification) and diaphragm 80 is associated with the overflow port (see page 6, line 15 of the original specification). While this may not be evident in reading original or amended claim 1, per se, or Fig 8, per se, it becomes clear in reviewing the specification. It is further noteworthy that applicant defines the sealing as *over* the respective ports and not *in* or *on*. To the extent set forth, there appears to be no new matter in the claims or drawing with respect to "sealing".

The Examiner's position regarding new matter with respect to cutting of the membrane 26A is well taken. The original specification merely refers to the removal of the membrane on page 8, line 2. There is no indication that an opening is cut through the opening. It appears from the specification that the whole membrane is removed and not even opened or cut. In this regard, Box 116 of Fig 8 contains new matter with respect to the cutting and opening of the membrane. Correspondingly, the insert to the specification in the response filed August 26, 2005 contains new matter. See the insert to page 9, line 25, last sentence of the first paragraph, repeated herein for the convenience of the reader: "The final step is wherein the diaphragms 26A, 80 are opened by physically cutting them open to permit fluid flow as shown in box 118 [sic, 116]." The statement is true for 80 but not 26A with respect to original support. Therefore, objectionable new matter under 35 USC §132 is present not only in new Fig 8, but in the amended specification.

Petitioner's request seeking relief of the Examiner's objections to employing a flow chart to show the method steps is granted. Flow charts are employable for the purpose intended by applicant. However, they may not contain new matter as noted above with respect to Box 116. (Please note that in Box 116, there is a spelling error with respect to "opend" that requires correction along with eliminating any new matter.)

In summary, the petitions are granted with respect to the use of "sealing" and use of a flow chart but dismissed with respect to "opening" and "cutting" for both diaphragms together since these terms are not applicable to membrane 26A.

GRANTED-IN-PART; DISMISSED-IN-PART.

It is noted that petitioner paid \$130.00 for each petition. There is no fee for a petition under 37 CFR §1.181. Both fees are refundable upon written request. See 37 CFR 1.26 and MPEP 607.02.

Any inquiry regarding this decision should be directed to Allan N. Shoap, Special Program Examiner, at (571) 272-4514.

Karen M. Young

Karen M. Young, Director
Technology Center 3700